

REMARKS/ARGUMENTS

In the Office Action mailed July 2, 2008, claims 27, 28, 30, 32-36, and 47-49 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Applicants have responded to the objection to claim 49 by correcting the informalities identified by the Examiner.

Claims 27, 33 and 48 have been amended. No new matter has been added. No claims have been added. Claim 32 has been canceled. As such, claims 27-28, 30, 33-36, and 47-49 remain pending.

DOUBLE PATENTING

The Examiner rejected claims 27, 28, 30, 32-36, and 47-49 on the ground of nonstatutory obviousness-type double patenting in view of claims 1-7 of U.S. Patent 6,254,535. Applicants hereby submit the attached terminal disclaimer directed to the above-identified patent and claims 27, 28, 30, 32-36, and 47-49 in the instant application.

In light of the foregoing arguments, withdrawal of the rejection of claims 27, 28, 30, 32-36, and 47-49 on the grounds of nonstatutory obviousness-type double patenting in view of claims 1-7 of U.S. Patent 6,254,535 is respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 27-28, 30, 32-33

The Examiner rejected claims 27-28, 30, 32-33, and 48 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 3, 240,516 to Barish *et al.* (hereinafter referred to as “Barish”) in view of U.S. Patent No. 4,606,522 to Heifetz (hereinafter referred to as “Heifetz”). Applicants traverse this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some reason to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *Id.* The Examiner has asserted that Barish allegedly discloses all of the limitations of the rejected claims except for that “a portion of said bore complementarily engages a portion of said shaft so that the interface therebetween controls the relative movement between said shaft and said bore as said shaft is moved within said bore.” To allegedly cure the deficiencies of Barish, the Examiner proffers Heifetz for its purported disclosure of a shaft and bore mechanism within a handle of the surgical instrument, wherein the shaft and bore are complementarily engaged. However, the Examiner fails to cite a reason to modify Barish to include these supposed teachings of Heifetz.

Indeed, “in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary [following the recent rule clarification by the Supreme Court in *KSR*] to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” Memorandum from Margaret Focarina, United States Patent & Trademark Office (“PTO”) Deputy Commissioner for Patent Operations,

to PTO Technology Center Directors on May 3, 2007. Thus, it remains true that “there must be some reason for the combination other than the hindsight gleaned from the invention itself,” as disclosed by the present Applicant’s disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

Applicants traverse this rejection on the basis that there would be no reason for one of ordinary skill to combine the cited references because the combination of Barish and Heifetz would render the combined invention inoperable. The multiple joint features of Heifetz are locked into a fixed position by a plurality of serial locking movements, wherein the engagement of the first locked joint forces the ball within the initial joint to be pushed against the adjacent joint as it mechanically triggers a *sequential* engagement of the second locked joint. (See Heifetz at Column 3, lines 18-26). This action is repeated until all joints are locked. The operator of the Heifetz instrument may add as many joints to the instrument as are necessary to allow the instrument to be maneuvered as desired by a surgeon. (See Heifetz at Column 3, lines 27-29). In contrast, Barish discloses a central joint feature in the middle segment of the handle, which when engaged, *simultaneously* locks an upper joint and a lower joint through a single vertical motion of the handle 64. (See Barish at Column 1, lines 8-17, Column 2, lines 54-66 and FIG. 1). The simultaneous vertical locking mechanism disclosed by Barish cannot be combined with the sequential serial horizontal joint feature of Heifetz. Applicants respectfully request the withdrawal of the rejection of claims 27-28, 30, 32-33, and 48.

However, in order to advance the prosecution of the application, Applicants have amended claims 27 and 48 to further clarify that the threading engagement is located on the shaft of the handle and “a portion of said bore complementarily engages a portion the threaded surface of said shaft so that the interface therebetween controls the relative movement between said shaft

and said bore as said shaft is moved within said bore.” These features are not present in Barish or Heifetz. Accordingly, the combination of Barish and Heifetz fails to supply all of the limitations of the invention as claimed.

Therefore, at least the reasons discussed above, claims 27-28, 30, 32-33, and 48, are not obvious under 35 U.S.C. § 103 in view of Barish and Heifetz. Applicants respectfully request that the rejection with regard to said claims be withdrawn.

Claims 34-36, 47 and 49

The Examiner has also rejected claims 34-36, 47 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Barish in view of Heifetz and further in view of U.S. Patent No. 2,674,501 to Biegler (hereinafter referred to as “Biegler”). The Examiner asserts that Biegler supplies the removable mounting feature disclosed in the above-identified claims. Applicants disagree. However, Applicants traverse on the basis that Biegler fails to cure the deficiencies of Barish in view of Heifetz discussed above. Biegler fails to disclose that “a portion of said bore complementarily engages a portion of the threaded surface of said shaft so that the interface therebetween controls the relative movement between said shaft and said bore as said shaft is moved within said bore.” Therefore, at least based on the reasons discussed above, claims 34-36, 47, and 49, as amended, are not obvious under 35 U.S.C. § 103 in view of Barish , Heifetz, and Biegler. Accordingly, Applicants respectfully request the withdrawal of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request all the objections and rejections to the specification and claims be removed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1545 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59742.22104.

Respectfully submitted,

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Date: November 3, 2008
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